

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of: **Masaru SUGANO et al.**

Art Unit: **2424**

Application Number: **09/863,352**

Examiner: **Farzana E. Hossain**

Filed: **May 24, 2001**

Confirmation Number: **1126**

For: **DESCRIPTION SCHEME AND BROWSING METHOD FOR AUDIO/VIDEO SUMMARY**

Attorney Docket Number: **010661**

Customer Number: **38834**

**REPLY BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

April 16, 2010

Sir:

In response to the Examiner's Answer mailed on March 4, 2010, the following is the Appellants' Reply Brief.

**REMARKS**

In response to the Examiner's Answer, Appellants herein respond to some comments therein.

In the section II.a., "Summary of the proposed modification of Terasawa" on pages 12 and 13 of the Examiner's Answer, it is stated that "the examiner is unsure as to why it is unclear what will occupy the space of program C if that is what is selected from the data stream of Terasawa." Appellants explain this uncertainty further. In Figure 4 of Terasawa, the apparatus is tuned to a program in the full-size screen (appears to be an image of trees). Appellants refer to this as program A. In the "slide," Terasawa illustrates still frames from five other programs. From left to right, Appellants refer to these as program B (includes an icon which appears to be

an artichoke), program C (includes an icon which appears to be a football), program D (no icon, appears to show two people), program E (includes an icon of a movie clapper board), and program F (includes an icon of music notes). As explained in Terasawa, if a user selects from program C, the apparatus will tune to program C as the main station. Terasawa does not disclose that the slide is retained on the screen—this is merely the Examiner’s hypothetical creation. Since there is no commentary in Terasawa or Gagnon on this point, *if* the slide was retained on the screen, it is unclear how the slide would appear after tuning to program C as the main program. It seems that the slide would still include programs B, D, E and F. However, since none of the cited art gives guidance on this, it unclear if the position which previously housed a still frame of program C would be (i) blank, (ii) a still frame of program A, or (iii) a still frame of another program. Appellants respectfully argue that this ambiguity in the operation of the proposed combination of cited art further illustrates the fact that it would not have been obvious to combine the cited art as proposed.

Next, in section II.b., “Gagnon is not relevant to the claims and thus should not be combined” on pages 13-15 of the Examiner’s Answer, the Examiner grossly mischaracterizes the holding of *KSR v. Teleflex*. The Examiner states that in *KSR*, the Supreme Court “found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield [*sic*] predictable results to one of ordinary skill in the art at the time of the invention.” Examiner’s Answer, page 15. In other words, the Examiner alleges that according to *KSR*, if all elements are known, then the combination is

obvious. Of course, under the Examiner's interpretation of *KSR*, nearly everything would be obvious and therefore unpatentable. Rather, the Supreme Court in *KSR* clearly stated otherwise: "A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." 550 U.S. 398, 418 (2007). (emphasis added). Additionally, the Supreme Court in *KSR* recognized that "inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 419. Thus, Appellants respectfully submit that the Examiner incorrectly applies *KSR*, which forms a large part of the basis for the improper rejection.

Next, Appellants discuss section II.c., "The combination does not disclose or suggest the embodiments of claims 10 and 19." As a preliminary comment, Appellants note that the Examiner divides Appellants' argument into "Argument 1," "Argument 2" and "Argument 3." The Examiner further sub-divides "Argument 3" into "Part 1" and "Part 2." Appellants respectfully note that this is an artificial division of Appellants' argument, and the Board is respectfully encouraged to ignore this artificial division. So-called "Argument 1" and "Argument 2" correspond to the text on page 13 and the first half of page 14. This text merely provided a background summary of the issues in controversy.

As to the merits, the Examiner's Answer states that the claims do not recite "a bidirectional transition between a particular program and its corresponding slide component." Page 17. Appellants note that this is because the bidirectional transition need not *necessarily* be between a particular program and its corresponding slide component. As illustrated in Figure 5B,

for example, the transition can be between the shortened segment of SONG 2 and the full SONG 2 (arrow “p”), between the full SONG 2 and the shortened segment of SONG 3 (leftmost arrow “q”) and between the full SONG 3 and the shortened segment of SONG 3 (rightmost arrow “q”). The claims require at least bidirectional transition between full programs and shortened segments of the full programs. However, whether or not the claimed bidirectional transition is applied to *corresponding* full programs and shortened programs is absolutely irrelevant to the question of whether or not the combination of cited art discloses bidirectional transition between the alleged “slide” and the programming. Neither Terasawa nor Gagnon discloses any bidirectional transition between its channel list and the actual programming. Rather, Gagnon merely discloses a series of unidirectional transitions between a channel list and the corresponding actual programming. Of course, Gagnon certainly does not disclose transition of any kind, unilateral or bilateral between full programs and shortened segments of programs, since Gagnon does not disclose shortened programs at all

Additionally, on page 18, the Examiner states that “the claim does not positively recite the bidirectional transition as it recites *allowing* for a bidirectional transition.” (emphasis in original). In response, Appellants note that the feature of “allowing for” bidirectional transition is a functional feature, which imparts further structure detail on textual description recited in the “providing” step.

Next, in “Part 2” of “Argument 3,” the Examiner states that “appellant argue that the combination does not disclose a bidirectional transition because it does not disclose a still frame C to program C and program C to still frame C.” See page 18 of the Examiner’s Answer. The

Examiner appears to be referring to the discussion on page 17 of the Appeal Brief. However, Appellants clarify that the lack of a program-C-to-still-frame-C transition is merely an *example* of the missing disclosure of Terasawa. Terasawa does not disclose or suggest *any* program-to-still-frame transition, regarding of whether it is program-C-to-still-frame-C, program-C-to-still-frame-D, or anything else. Terasawa only discloses unidirectional still-frame-to-program transitions, and does not disclose any program-to-still frame transitions. Finally, In "Part 3" of "Argument 2," the Examiner merely restates her position in a conclusory manner without providing any additional substantive comments.

Next, Appellants discuss section II.d., "The combination of cited art does not disclose or suggest Claims 28-33." Again, Appellants note that the Examiner divides Appellants' argument into "Argument 1" and "Argument 2". Appellants respectfully note that this is an artificial division of Appellants' argument, and the Board is respectfully encouraged to ignore this artificial division. First, the Examiner criticizes Appellants remarks regarding Figure 5 as "arguing limitations as viewed by the appellant's specification versus that claim limitations which are broader in scope." See page 20 of the Examiner's Answer. Appellants respectfully note that the discussion with regard to Figure 5 was merely provided as an *example* of the subject matter of claims 28 and 29. As to "Argument 1," the Examiner merely repeats the unreasonable interpretation which relies on a user pressing a button at *exactly* at the time when one program ends and the next program begins.

As to "Argument 2," Appellants first respectfully submit that, as discussed above, Terasawa only discloses unidirectional still-frame-to-program transitions, and does not disclose

any program-to-still frame transitions. Although in Figure 35 and 36, Terasawa appears to disclose a variety of options with regard to still-frame-to-program transitions, it does not disclose or suggest any program-to-still-frame transitions. As to sequentially next programs, Appellants respectfully submit that even though it appears to be possible to view a still frame and program information (channel, time, duration, etc.) for a future program (see col. 20, line 62 to col. 21 line 4), it is inherently impossible to transition to this program, since it has not yet aired. Thus, for at least these reasons, Appellants respectfully submit that the combination of cited art does not disclose or suggest a transition from an original program to a sequentially next shortened segment of an original program, as required by claims 28 and 29. Additionally, Appellants respectfully note that the Examiner provided no comments regarding claims 30-33 regarding "playing" slide components. Appellants respectfully submit that this further illustrates that the cited art does not disclose or suggest the embodiments as claimed.

Finally, Appellants discuss section II.e., "The combination does not disclose or suggest the embodiments of claims 36-57." Again, Appellants note that the Examiner divides Appellants' argument into "Argument 1," "Argument 2," "Argument 3," "Argument 4" and "Argument 5." Appellants respectfully note that this is an artificial division of Appellants' argument, and the Board is respectfully encouraged to ignore this artificial division.

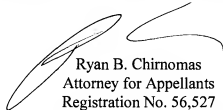
"Argument 1" and "Argument 2" are merely a rephrasing of Appellants' summary of pre-Appeal Brief remarks by the Examiner. In "Argument 3," the Examiner states that that "The phrase "audio slide" does not require that the slide must have sound." See page 24 of the Examiner's Answer. The Examiner attempts to side-step Appellants' arguments by stating that

"The broadest reasonable interpretation of forming an audio slide can be interpreted as forming a slide of audio programs." See page 24 of the Examiner's Answer. Yet, in the first sentence of page 24, the Examiner states that she "agrees that an audio program must include sound." Thus, an audio slide must include sound, since it is made up of audio programs which themselves each "must include sound" by the Examiner's own admission. Additionally, Appellants respectfully reiterate that since the adjective "audio" modifies the noun "slide," the recited slide must include audible sound. Appellants respectfully submit that it is far beyond the broadest reasonable interpretation of the claim terms to interpret a series of silent still frames as an "audio slide."

Thus, for at least the above reasons, Appellant requests that the Honorable Board reverse the Examiner's rejection.

Respectfully submitted,

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